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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,319	09/29/2000	Ernie F. Brickell	10559/329001/P9832	1992

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EXAMINER

HENNING, MATTHEW T

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/676,319	Applicant(s) BRICKELL ET AL.	
	Examiner Matthew T. Henning	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-46 is/are rejected.
- 7) ☒ Claim(s) 42 and 50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/21/05</u> <u>4/18/06</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2131

1 This action is in response to the communication filed on 3/16/2006.

2 **DETAILED ACTION**

3 Claims 1-41 have been cancelled and new claims 42-65 have been examined.

4 All objections and rejections not specifically addressed below have been withdrawn.

5 ***Response to Arguments***

6 Regarding applicants' request for a better explanation of the objection to claims 42 and
7 50, the examiner presents the following. The phrase "at an authentication service" implies that
8 the authentication service is a location. This is not the case, but instead the authentication
9 service is a service. Therefore the phrase should read simply "an authentication service,
10 receiving" as this is grammatically proper.

11 The examiner would like to point out that the arguments' regarding the prior art presented
12 in the communication dated 3/16/2006 are not consistent with the rejection presented by the
13 examiner on 7/28/2005. The applicants' have pointed to Fig. 5 of Sheehan, but there is no Fig. 5
14 of Sheehan. It appears that in all the arguments' the applicants' have said "Sheehan" when
15 meaning "Saito" and vice versa. Therefore, the examiner will address the arguments accordingly.

16 Regarding applicants' argument that the user of [Saito] is not involved in the
17 authentication process except as the recipient of services, the examiner does not find the
18 argument persuasive. The applicants' seem to have ignored that the examiner is relying on the
19 "client" of Saito as the "first user" which was clearly pointed out page 4 Line 7 of the rejection
20 presented 7/28/2005. And the client of Saito is clearly involved in the authentication process.
21 Therefore, the examiner does not find the argument persuasive.

Claim Objections

Claims 42 and 50 recite the limitation “at an authentication service” which is not grammatically correct.

Claim Rejections - 35 USC § 103

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

Art Unit: 2131

1 *ordinary skill in the art to which said subject matter pertains. Patentability shall not be*
2 *negated by the manner in which the invention was made.*

3
4 Claims 42-43, 46, 48-51, 54, 56-59, 62, and 64-65 are rejected under 35 U.S.C. 103(a) as
5 being unpatentable over Sheehan et al. (US Patent Number 6,311,163) hereinafter referred to as
6 Sheehan, and further in view of Saito et al. (US Patent Number 6,275,941) hereinafter referred to
7 as Saito.

8 Regarding claims 42, 50 and 58, Sheehan disclosed a system, method, and software for a
9 prescribing party to issue a prescription through a communication network such as the Internet,
10 in which the prescribing party includes doctors, health service providers, and other authorized
11 personnel (See Sheehan Abstract and Col. 3 Lines 45-57, Col. 4 Lines 47-49, and Fig. 4).
12 However, Sheehan failed to disclose a method for ensuring that the prescribing party was in fact
13 authorized to issue prescriptions.

14 Saito teaches a system for authenticating a user (See Saito Fig. 5 and Col. 7 Lines 5-55)
15 involving storing authentication information for a plurality of users (See Saito Col. 7 Lines 25-26
16 wherein the public keys of users must have been stored in order for them to be accessed by the
17 authentication server); at an authentication service (authentication server), receiving digital
18 credential information (integrated certificate) associated with a first user (client) from a relying
19 party (application server) (See Saito Col. 7 Lines 21-24); verifying the digital credential
20 information associated with the first user to the relying party (See Saito Col. 7 Lines 25-36);
21 providing verification information associated with the first user to the relying party (See Saito
22 Col. 7 Lines 36-52); and providing information from the authentication service to the first user,
23 the information indicative of receiving the digital credential information associated with the first
24 user from the relying party (See Saito Col. 7 Lines 36 – Col. 8 Line 8). Saito further teaches

Art Unit: 2131

1 providing information to the first user comprises providing access to an activity log associated
2 with the first user (See Saito Col. 8 Lines 3-5 and 36-44).

3 It would have been obvious to the ordinary person skilled in the art at the time of
4 invention to employ the teachings of Saito in the prescription issuing system of Sheehan by
5 having the prescribing doctor send an integrated certificate to the server, and having the server
6 authenticate the certificate and doctor via an authentication server. This would have been
7 obvious because the ordinary person skilled in the art would have been motivated to ensure that
8 only authorized doctors were issuing prescriptions.

9 Regarding claims 43, 51, and 59, the combination of Sheehan and Saito disclosed
10 providing access to an activity log associated with the first user (See Saito Col. 8 Lines 3-5 and
11 36-44).

12 Regarding claims 46, 54, and 62, the combination of Sheehan and Saito disclosed storing
13 access information associated with the relying party, the access information including
14 information indicative of the providing the verification information associated with the first user
15 (See Saito Col. 7 Lines 44-52); and providing the access information to the relying party (See
16 Saito Col. 7 Lines 44-52).

17 Regarding claims 48, 56, and 64, the combination of Sheehan and Saito disclosed that
18 providing verification information to the relying party comprises providing information
19 indicative of a failure to authenticate the digital credential information associated with the first
20 user (See Saito Col. 7 Lines 36-38).

21 Regarding claims 49, 57, and 69, the combination of Sheehan and Saito disclosed at least
22 one of the relying party and the authentication service issuing a challenge in response to

Art Unit: 2131

1 receiving digital credential information associated with the first user (See Saito Col. 7 Lines 21-
2 24).

3 Claims 44-45, 47, 52-53, 55, 60-61, and 63 are rejected under 35 U.S.C. 103(a) as being
4 unpatentable over the combination of Sheehan and Saito as applied to claims 42, 50, and 58
5 above, and further in view of State of Colorado (Senate Bill 97134 LLS NO. 970530.01)
6 hereinafter referred to as Colorado.

7 The combination of Sheehan and Saito disclosed an authentication server verifying an
8 integrated certificate of a doctor and sending the result to the prescription server prior to
9 allowing prescriptions to be issued (See the rejection of claim 42 above), but failed to disclose
10 verifying registration information with a registration authority.

11 Colorado teaches that in order to write a prescription in the state of Colorado, an
12 advanced practice nurse must be listed on the advanced practice registry, have a license in good
13 standing without disciplinary sanctions, and have fulfilled requirements established by the board
14 (See Colorado Section 7).

15 It would have been obvious to the ordinary person skilled in the art at the time of
16 invention to employ the teachings of Colorado in the prescribing party authorization system of
17 Sheehan and Saito by checking the standing of the medical license of the party, whether they are
18 registered on the advance practice registry, and the status of fulfillment of the requirements
19 established by the board. This would have been obvious because the ordinary person skilled in
20 the art would have been motivated to ensure that all legal requirements for issuing prescriptions
21 were fulfilled prior to authorizing the party to issue prescriptions.

Conclusion

Claims 42-65 have been rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790. The examiner can normally be reached on M-F 8-4.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2131

1 Information regarding the status of an application may be obtained from the Patent
2 Application Information Retrieval (PAIR) system. Status information for published applications
3 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
4 applications is available through Private PAIR only. For more information about the PAIR
5 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR
6 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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17 Matthew Henning
18 Assistant Examiner
19 Art Unit 2131
20 5/18/2006
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